IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellants:	Bates *et al.*	**Conf. No.:**	9951
Serial No.:	10/062,102	**Art Unit:**	2173
Filing Date:	01/31/2002	**Examiner:**	Basom, Blaine T.
Title:	METHOD AND SYSTEM FOR SELECTING MULTIPLE SETS OF DATA IN AN APPLICATION	**Docket No.:**	END920010052US1 (IBME-0027)

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Commissioner for Patents
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SUPPLEMENTAL BRIEF OF APPELLANTS

This is an appeal from the Final Rejection dated December 1, 2008, rejecting claims 1-26 and in response to the Notice of Non-Compliant Appeal Brief received on June 30, 2009. This Brief is accompanied by the requisite fee set forth in 37 C.F.R. 1.17 (c).

REAL PARTY IN INTEREST

International Business Machines Corporation is the real party in interest.

RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

STATUS OF CLAIMS

As filed, this case included claims 1-26. Claims 2-8 and 10-26 were canceled via amendment. Claims 1 and 9 remain pending. Claims 1 and 9 stand rejected and form the basis of this appeal.

STATUS OF AMENDMENTS

An amendment that incorporated subject matter from dependent claims and canceled all other claims was submitted in response to the After Final Rejection filed by the Office on December 1, 2008. This amendment was entered by the Office on March 24, 2009.

SUMMARY OF THE CLAIMED SUBJECT MATTER

The claimed invention provides a method and system for selecting multiple sets of data in an application. Specifically, under the claimed invention, a first set of data is selected. Then, a predetermined keystroke is performed. After the keystroke is performed, a second set of data can be selected while the first set of data remains selected. The claimed invention also allows for multiple portions of a selected set of data to be selected. Specifically, the user can select a first portion of a selected set of data, perform another keystroke, and then select a second portion of the set while both the first portion and the set remain selected.

Claim 1 claims a method for selecting multiple sets of data in an application (see e.g., page 8, line 16 through page 9, line 9; Fig. 1, item 12), comprising the steps of: selecting a first set of data within the application (see e.g., page 9, lines 19-21; Fig. 2, item 50); and selecting a second set of data within the application (see e.g., page 10, lines 3-5; Fig. 2, item 52), wherein the first set of data remains selected during the selection of the second set of data (see e.g., page

10, lines 3-5; Fig. 2, items 50, 52), wherein the method is adapted to allow selecting of the second set of data anywhere within the application irrespective of a location of the first set of data (see e.g., page 10, line 11 through page 11, line 24; Fig. 2, items 50, 52), wherein the method is adapted to allow selection of the second set of data that overlaps the first set of data (see e.g., page 10, line 11 through page 12, line 6).

Claim 9 claims a method for selecting multiple sets of data in an application, comprising the steps of: providing an application for manipulating data (see e.g., page 8, line 16 through page 9, line 9; Fig. 1, item 12); selecting a first set of data within the application (see e.g., page 9, lines 19-21; Fig. 2, item 50); performing a first predetermined keystroke (see e.g., page 9, line 22 through page 10, line 10); and selecting a second set of data within the application (see e.g., page 10, lines 3-5; Fig. 2, item 52), wherein the first set of data remains selected during the selection of the second set of data (see e.g., page 10, lines 3-5; Fig. 2, items 50, 52), wherein the method is adapted to allow selecting of the second set of data anywhere within the application irrespective of a location of the first set of data (see e.g., page 10, line 11 through page 11, line 24; Fig. 2, items 50, 52), wherein the method is adapted to allow selection of the second set of data that overlaps the first set of data (see e.g., page 10, line 11 through page 12, line 6).

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 1-3, 7-9 and 14-16 were rejected under 35 U.S.C. §102(a) as being anticipated by Flemming *et al.* (U.S. Patent No. 5,664,210), hereafter "Flemming."
2. Claims 4-6, 10-13 and 17-26 were rejected under 35 U.S.C. §103(a) as being unpatentable over Flemming in view of Hussam *et al.* (W.O. Patent Pub. No. 01/29707 A1), hereafter "Hussam."

ARGUMENT

1. REJECTION OF CLAIMS 1-3, 7-9 AND 14-16 (NOW ALL EITHER AMENDED TO INCLUDE SUBJECT MATTER FROM CLAIMS REJECTED UNDER 35 U.S.C. §103(a)) OVER FLEMMING

In the Final Office Action, the Examiner rejects claims 1-3, 7-9 and 14-16 under 35 U.S.C. §103(a). Appellants have amended claims 1 and 9 after final to include the subject matter of claims 6 and 13, respectively, and have canceled all other claims. This amendment was entered by the Examiner in the Advisory Action dated March 24, 2009. As such, Appellants respectfully contend that the rejection under 35 U.S.C. §103(a) is no longer applicable to the above claims. For this reason, Appellants respectfully address their remarks to the claims in the following section.

2. REJECTION OF CLAIMS 4-6, 10-13 AND 17-26 (NOW 1 AND 9) UNDER 35 U.S.C. §103(a) OVER FLEMMING AND HUSSAM

In the Final Office Action, the Examiner rejects claims 4-6, 10-13 and 17-26 under 35 U.S.C. §103(a). Appellants have amended claims 1 and 9 after final to include the subject matter of claims 6 and 13, respectively, and have canceled all other claims. This amendment was entered by the Examiner in the Advisory Action dated March 24, 2009. Accordingly, Appellants respectfully address their remarks to the remaining claims herein.

Appellants respectfully submit that the rejection of claims 1 and 9 under 35 U.S.C. 103(a) over Flemming and Hussam is defective.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Second, there must be a reasonable expectation of success.

Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Appellants respectfully submit that the Flemming and Hussam references, taken alone or in combination, fail to meet each of the three basic criteria required to establish a *prima facie* case of obviousness. As such, the rejection under 35 U.S.C. §103(a) is defective.

In the above referenced Final Office Action, the Examiner alleges that the cited references teach or suggest that the method is adapted to allow selection of the second set of data that overlaps the first set of data. The Examiner admits that Flemming does not specifically teach this feature. Instead, the Examiner relies on a passage of Hussam which it says teaches highlighting a set of data within another set of data. However, even assuming, *arguendo*, the Examiner's statement, the data sets of the passage in Hussam cited by the Examiner are not overlapping, i.e., they do not each have portions that are outside of the other. Instead, one set of data in Hussam is entirely within the other. To this extent, the selection of data within another set of data of Hussam does not teach or suggest the overlapping sets of data of the claimed invention.

CONCLUSION

In summary, Appellants submit that claims 1 and 9 are allowable because the cited references, taken alone or in combination, fail to meet each of the three basic criteria required to establish a *prima facie* case of obviousness.

Respectfully submitted,

/Hunter E. Webb/

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CLAIMS APPENDIX

Claim Listing:

1. A method for selecting multiple sets of data in an application, comprising the steps of:

selecting a first set of data within the application; and

selecting a second set of data within the application, wherein the first set of data remains selected during the selection of the second set of data,

wherein the method is adapted to allow selecting of the second set of data anywhere within the application irrespective of a location of the first set of data,

wherein the method is adapted to allow selection of the second set of data that overlaps the first set of data.

9. A method for selecting multiple sets of data in an application, comprising the steps of:

providing an application for manipulating data;

selecting a first set of data within the application;

performing a first predetermined keystroke; and

selecting a second set of data within the application, wherein the first set of data remains selected during the selection of the second set of data,

wherein the method is adapted to allow selecting of the second set of data anywhere within the application irrespective of a location of the first set of data,

wherein the method is adapted to allow selection of the second set of data that overlaps the first set of data.

EVIDENCE APPENDIX

No evidence is entered and relied upon in the appeal.

RELATED PROCEEDINGS APPENDIX

No decisions rendered by a court or the Board in any proceeding are identified in the related appeals and interferences section.